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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/646,825	09/22/2000	Satoshi Mori	55022	1169

7590 11/23/2001

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EXAMINER

NGUYEN, LIEN-CHI A

ART UNIT	PAPER NUMBER
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1635

DATE MAILED: 11/23/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/646,825

Applicant(s)

MORI ET AL.

Examiner

Lauren Nguyen

Art Unit

1635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☒ Claim(s) 17-21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_
- 4) ☒ Interview Summary (PTO-413) Paper No(s) \_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction is required under 35 U.S.C. 121 and 372. This application contains the following groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1. In accordance with 37 CFR 1.499, Applicant is required in response to this Action, to elect a single invention to which the claims must be restricted.

- I. Group I, claims 1-16, drawn to a method for transforming a useful plant by introducing a gene of another species into the useful plant.
- II. Group II, claims 17-21, drawn to nucleic acids and method for producing the nucleic acid used in the claimed method of Group I.

The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1, because, under PCT Rule 13.2, they lack the same or corresponding special technical feature for the following reasons:

The special technical feature of Group I is a gene of another species besides plant wherein the region of a factor relating to the poly(A) addition of an mRNA contains a modified base sequence. The special technical feature of Group II is a nucleic acid sequence corresponding to SEQ ID No.1 which encodes for ferric-chelate reductase, FRE1. Each group is drawn to different chemical entities as evidenced by unique SEQ ID No.1 and therefore, each claimed group is drawn to patentably distinct inventions.

During a telephone conversation with George Neuner on October 23, 2001 a provisional election was made without traverse to prosecute the invention of Group II, claims 17-21.

Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-16 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

2. It is noted that the Examiner contacted George Neuner on November 6, 2001 and Peter Corless on November 9, 2001 to notify Applicants of the problematic recitation in claims 17-21 *i.e.* multiple-dependency and recitation directed to non-elected inventions. During the telephonic conversation with Peter Corless, Applicant had agreed to fax a preliminary amendment to claims 17-21. (Please refer to Interview Summary, entered in the file as Paper No.7.) As of November 15, 2001, a preliminary amendment still has not been received by the Examiner. Another telephone call and voice-mail message to Peter Corless on November 13, 2001 was placed by the Examiner to inquire about the status of the preliminary amendment. As of November 15, 2001, Mr. Corless has not responded to the Examiner's voice-mail message.

Therefore, claims 17-20 were not examined on the merits for the following reasons:

*Claim Objections*

3. Claims 17-21 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot dependent on any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

4. Claims 17-21 are objected to as reciting dependency on a non-elected invention. Accordingly, the claims have not been further treated on the merits.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Nguyen, Ph.D. whose telephone number is 703-308-0256. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John LeGuyader can be reached on 703-308-0447. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-305-7939 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Lauren Nguyen, Ph.D.  
November 15, 2001

  
**ANDREW WANG**  
**PRIMARY EXAMINER**